



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,037	08/30/2001	Thomas Seitz	514413-3894	8456
20999	7590	11/05/2003	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			TRUONG, TAMTHOM NGO	
			ART UNIT	PAPER NUMBER
			1624	8

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/943,037

Applicant(s)

SEITZ ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- Th MAILING DATE of this c mmunicati n appears on the c ver sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-8 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8, and 13-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 8-4-03 is entered and acknowledged. However, a careful review of the claims, the following restriction is necessary.

Election/Restrictions

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-8 (in part), 14-19 (in part), drawn to compounds, compositions of formula I having the following substituents:

Z is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **monocyclic** radical;

$q = 0$, $o = 0$, and $p = 0$,

Also method of controlling undesired plants using said compounds, classified in classes 504, 564, and 568, various subclasses depending on substituents.

2. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is N-H, N-(C₁-C₄)alkyl;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **monocyclic** radical;

Art Unit: 1624

 $q = 0, o = 0, \text{ and } p = 0,$

classified in classes 504, 548, various subclasses depending on substituents.

3. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

 $Z \text{ is } O, S, SO, SO_2;$ $Y \text{ is } -CHR^5 \text{ or } -C(R^5)_2;$ $C^1(C^2)_q(C^3)_o$ represents a **monocyclic** radical; $q = 0, o = 0, \text{ and } p = 0,$

Also method of controlling undesired plants using said compounds,

classified in classes 504, 549, various subclasses depending on substituents.

4. Claims 1-8 (in part), and 14-19 (in part), drawn to compounds, compositions of formula I having the following substituents:

 $Z \text{ is } -CHR^5 \text{ or } -C(R^5)_2;$ $Y \text{ is } -CHR^5 \text{ or } -C(R^5)_2;$ $C^1(C^2)_q(C^3)_o$ represents a **monocyclic** radical; $q = 0, o = 0, \text{ and } p = 1,$

Also method of controlling undesired plants using said compounds,

classified in classes 504, 564, and 568, various subclasses depending on substituents.

5. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Art Unit: 1624

Z is N-H, N-(C₁-C₄)alkyl;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **monocyclic** radical;

q = 0, o = 0, and p = 1,

Also method of controlling undesired plants using said compounds,

classified in classes 504, 546, various subclasses depending on substituents.

6. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is O, S, SO, SO₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **monocyclic** radical;

q = 0, o = 0, and p = 1,

Also method of controlling undesired plants using said compounds,

classified in classes 504, 549, various subclasses depending on substituents.

7. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is -CHR⁵ or -C(R⁵)₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **bicyclic** radical;

q = 0, o = 0, and p = 0,

Also method of controlling undesired plants using said compounds,

Art Unit: 1624

classified in classes 504, 564, and 568, various subclasses depending on substituents. Further restriction will be required if this group is elected.

8. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is N-H, N-(C₁-C₄)alkyl;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **bicyclic** radical;

q = 0, o = 0, and p = 0,

classified in classes 504, 548, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

9. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is O, S, SO, SO₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **bicyclic** radical;

q = 0, o = 0, and p = 0,

classified in classes 504, 549, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

10. Claims 1-3, 5, 7, 8, and 14-19 (in part), drawn to compounds, compositions of formula I having the following substituents:

Z is -CHR⁵ or -C(R⁵)₂;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **bicyclic** radical;

$q = 0$, $o = 0$, and $p = 1$,

Also method of controlling undesired plants using said compounds, classified in classes 504, 564, and 568, various subclasses depending on substituents. Further restriction will be required if this group is elected.

11. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is N-H, N-(C₁-C₄)alkyl;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **bicyclic** radical;

$q = 0$, $o = 0$, and $p = 1$,

classified in classes 504, 546, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

12. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is O, S, SO, SO₂;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **bicyclic** radical;

$q = 0$, $o = 0$, and $p = 1$,

Art Unit: 1624

classified in classes 504, 549, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

13. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **tricyclic** radical;

$q = 0$, $o = 0$, and $p = 0$,

Also method of controlling undesired plants using said compounds,

classified in classes 504, 564, and 568, various subclasses depending on substituents. Further restriction will be required if this group is elected.

14. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is N-H, N-(C₁-C₄)alkyl;

Y is $-\text{CHR}^5$ or $-\text{C}(\text{R}^5)_2$;

$\text{C}^1(\text{C}^2)_q(\text{C}^3)_o$ represents a **tricyclic** radical;

$q = 0$, $o = 0$, and $p = 0$,

classified in classes 504, 548, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

15. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Art Unit: 1624

Z is O, S, SO, SO₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **tricyclic** radical;

q = 0, o = 0, and p = 0,

classified in classes 504, 549, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

16. Claims 1-3, 5, 7, 8, and 14-19 (in part), drawn to compounds, compositions of formula I having the following substituents:

Z is -CHR⁵ or -C(R⁵)₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **tricyclic** radical;

q = 0, o = 0, and p = 1,

Also method of controlling undesired plants using said compounds,

classified in classes 504, 564, and 568, various subclasses depending on

substituents. Further restriction will be required if this group is elected.

17. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is N-H, N-(C₁-C₄)alkyl;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **tricyclic** radical;

q = 0, o = 0, and p = 1,

Art Unit: 1624

Also method of controlling undesired plants using said compounds,
classified in classes 504, 546, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

18. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having the following substituents:

Z is O, S, SO, SO₂;

Y is -CHR⁵ or -C(R⁵)₂;

C¹(C²)_q(C³)_o represents a **tricyclic** radical;

q = 0, o = 0, and p = 1,

Also method of controlling undesired plants using said compounds,
classified in classes 504, 549, various subclasses depending on substituents.

Further restriction will be required if this group is elected.

19. Claims 1-3, 5, 7, 8, and 14-19 (part of each), drawn to compounds, compositions of formula I having a combination of substituents that is not in the above groups.

Also, method of controlling undesired plants using said compounds, classified in classes 504, 540, 544, 546, 548, and 549, various subclasses depending on substituents. Further restriction will be required if this group is elected.

20. Claim 13, drawn to the **intermediate** of formula (IIIa), classified in class 540, 544, 546, 548, and 549, various subclasses depending on substituents.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1624

B. Inventions of Groups 1-20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated for the following reasons:

a. The formula (I) in Groups 1-19 are drawn to compounds of various combinations of ring systems. Although said groups share a core of $-C(=O)-phenyl$, such a core is well known (as evident by the attached CAS printout), and is not applicant's contribution to the art. Thus, the compounds of each group is defined by the ring having Z-Y, and p, in combination with the ring system of $C^1(C^2)_q(C^3)_o$, and the core. It is the combination of said ring systems that gives the compounds in each group their physical and chemical properties that are patentably distinct. Therefore, a reference that anticipated compounds of one group would not do so to the other groups, and thus, a separate search for each group would be required, which would pose a burden of searching.

b. Inventions Groups 1-19 and 20 are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful to make another agricultural products (as evident by the reference of **Engel et. al.** (WO 99/10327 – cited on IDS)), and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the

Art Unit: 1624

ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and the search required for Group 1 is not required for Groups 2-20, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Michelle Ekanemesang on 11-03rd-03 to request an oral election to the above restriction requirement, but a written restriction is preferred since Mr. Mark Russell (the attorney of record) was not available at the time.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1st -03).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

November 3, 2003



JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624
 SUPERVISORY PATENT EXAMINER
ART UNIT 1624